

JPW

Dkt. 71341/JPW/PT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nobuhiro Tamura et al.

Serial No.: 10/700,399

Group Art Unit: 2879

Filed: November 3, 2003

Examiner: Natalie K. Walford

For: METAL HALIDE LAMP, HEADLIGHT APPARATUS FOR VEHICLE USING
THE SAME, AND METHOD OF MANUFACTURING METAL HALIDE LAMP

1185 Avenue of the Americas
New York, New York 10036
October 25, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO OCTOBER 4, 2005 OFFICE ACTION

This Communication is submitted in response to the October 4, 2005 Office Action issued by the U.S. Patent and Trademark Office in connection with the above-identified patent application. A response to the October 4, 2005 Office Action is due November 4, 2005. Accordingly, this response is being timely filed.

The October 4, 2005 Office Action indicates that examination of the application will be restricted under 35 U.S.C. §121 to one of the following allegedly distinct inventions:

Group I. Claims 1-13, drawn to the device of a metal halide lamp, classified in class 313, subclass 638; and

Group II. Claims 14-19, drawn to method of manufacturing a metal halide lamp, classified in class 445, subclass 26.

In the October 4, 2005 Restriction Requirement, the Examiner alleged that the inventions are distinct, each from the other.

However, the Examiner acknowledged that the inventions of the metal halide lamp and method of manufacturing a metal halide lamp are related as process and apparatus for its practice.

The Examiner stated that the inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. The Examiner further stated that in this case, the apparatus as claimed can be used to practice another and materially different process.

The Examiner stated that because these inventions are allegedly distinct for the reasons given and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The Examiner stated that for the response to this restriction requirement to be complete the response must include an election of the invention to be examined even though the requirement be traversed.

Applicant hereby elects, with traverse, to prosecute the invention of Group I, claims 1-13, drawn to the device of a metal halide lamp.

Applicant, however, respectfully requests that the Examiner reconsider and withdraw the restriction requirement.

Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

The inventions of Groups I and II are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subjects disclosed. As acknowledged in the Office Action, the invention of Group II, drawn to method of manufacturing a metal halide lamp, is related to the invention of Group I, drawn to the device of a metal halide lamp, as process and apparatus for its practice. Applicant therefore maintains that the Groups are not independent and restriction is improper.

Applicant further maintains that it would not be a serious burden on the Examiner if restriction is not required, because a search of the prior art for Group I would likely identify art for Group II. Applicant therefore maintains that the search and examination of the claims of Group II in addition to the claims of Group I would not be a serious burden on the Examiner. Since there is no burden on the Examiner to examine Groups I and II of the subject application, the Examiner must examine the inventions of Groups I and II on the merits.

Accordingly, in view of the preceding remarks, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement.

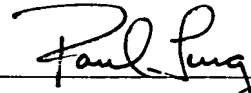
No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit

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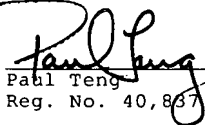
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Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Paul Teng
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October 25, 2005
Date